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MOTION FILED
AUG 2 - 2006

No. 04-1350

In the Supreme Court of the United States

KSR INTERNATIONAL CO.,
Petitioner,

v.

TELEFLEX INC. and
TECHNOLOGY HOLDING CO.,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

MOTION FOR LEAVE TO FILE *AMICI BRIEF* and BRIEF OF JOSEPH V. COLAIANNI, SR. and JAMES E. ARMSTRONG, III, AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

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MOTION FOR LEAVE TO FILE AMICUS BRIEF

Pursuant to Rule 37.3(b) of the Rules of the Supreme Court of the United States, Joseph V. Colaianni, Sr., and James E. Armstrong, III, hereby respectfully request leave to file the accompanying *amici curiae* brief. This brief is submitted in support of the *Petitioner's Brief*. Petitioner KSR International Co. has consented to the filing of this brief. Respondents Teleflex Inc. and Technology Holding Co. have not consented to the filing of this brief.

The movants' strong interest in the proper interpretation and application of intellectual property law in this case stem from their current practice in intellectual property law at two international law firms with offices in the United States, Japan, and Qatar. In addition, Mr. Colaianni's interest derives from his experience as a judge at the United States Court of Federal Claims between 1970 and 1984. Mr. Armstrong's interest in the obviousness standard of Section 103 of the Patent Act, 35 U.S.C. §103, results from forty-eight years of practice in patent law.

The movants are greatly concerned that the incorrect emphasis the current Federal Circuit places on motivation as taught by printed references to combine prior art misses the ultimate issue of proper obviousness analysis under Section 103 of the Patent Act, 35 U.S.C. §103, namely giving full recognition to the level of skill of the person having ordinary skill as a vital part of the relevant art. The teaching, suggestion, or motivation test as applied by the current Federal Circuit in its interpretation of the obviousness standard strays from the Constitutional intent and this Court's prior pronouncement to secure for the public domain inventions that should be unpatentable because of

obviousness. Accordingly, the movants respectfully request leave to file the accompanying *amici curiae* brief.

Respectfully submitted,

Joseph V. Colaianni, Sr.
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TABLE OF CONTENTS

Page

TABLE OF CONTENTS iii

TABLE OF AUTHORITIES iv

INTEREST OF AMICUS CURIAE 1

REASONS FOR GRANTING THE WRIT 2

I. The Federal Circuit Erred in Deviating From the Statutory Standard of 35 U.S.C. §103 and From This Court's Controlling Precedent, *Graham v. John Deere*, in Solely Applying the Teaching, Suggestion, or Motivation Test to the Question of Obviousness 2

II. The Federal Circuit Erred in Deviating From Its Own Earlier Line of Precedent Beginning With *Kimberly-Clark Corp. v. Johnson and Johnson Co.* and *EWP v. Reliance* in Solely Applying the Teaching, Suggestion, or Motivation Test to the Questions of Obviousness 8

III. The Supreme Court Should Review *KSR* and Direct the Federal Circuit to Return to the Obviousness Standard of *Graham v. John Deere* and the Federal Circuit's Earlier Line of Precedent 14

CONCLUSION 19

TABLE OF AUTHORITIES

CASES: Page

EWP Corp. v. Reliance Universal Inc.,
755 F.2d 898 (Fed. Cir. 1985) . . . . . *passim*

Gillette Co. v. S.C. Johnson & Son Inc.,
919 F.2d 720 (Fed. Cir. 1990) 18, 19

Graham v. John Deere Co.,
383 U.S. 1 (1966) . . . . . *passim*

Hotchkiss v. Greenwood,
52 U.S. 248 (1850) 3, 4, 9, 10, 16, 17

In re Hans Oetiker,
977 F.2d 1443 (Fed. Cir. 1992) 13, 18

Kimberly-Clark Corp. v. Johnson and Johnson Co.,
745 F.2d 1437 (Fed. Cir. 1984) . . . . . *passim*

Lamb-Weston v. McCain Foods,
73 F. 3d 546 (Fed Cir. 1996) 13

Teleflex Inc., v. KSR,
119 Fed. Appx. 282 (Fed. Cir. 2005)
(unpublished) 14, 15, 16, 17

CONSTITUTION AND STATUTES:

U.S. Const, art. I, §8, cl. 8 2

35 U.S.C. 103 3

INTEREST OF THE *AMICI CURIAE*

Amici Curiae Joseph V. Colaianni, Sr., and James E. Armstrong, III, respectfully submit this brief in support of petitioner, KSR International Co., encouraging reversal of the judgment of the United States Court of Appeals for the Federal Circuit, because that judgment results from an incorrect application of an obviousness test that is inconsistent with this Court's precedent as well as a line of Federal Circuit precedent and the Constitutional intent behind patent protection.[1]

Amici are lawyers who practice intellectual property law at two international law firms with offices in the United States, Japan, and Qatar, and have an interest in the proper interpretation and application of intellectual property law. In particular, Mr. Colaianni decided numerous patent claims as a judge for the United States Court of Federal Claims between 1970 and 1984. While on the court, Mr. Colaianni interpreted Section 103 of the Patent Act, 35 U.S.C. §103, to distinguish between nonobvious inventions deserving patent protection and obvious inventions to be left in the public domain. Mr. Armstrong has been registered before the United States Patent and Trademark Office to practice patent law since 1957. In his forty-eight years of practice, which began just five years after the inclusion in the Patent Act of 1952 of the obviousness standard as a condition for patentability, Mr. Armstrong encountered the issue of obviousness during patent prosecution, validity opinions, and litigation. *Amici* believe that the patent law ought to be

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[1] Pursuant to this Court's Rule 37.6, *amici* represent that this brief was not authored in whole or in part by counsel for any party, and that no person or entity other than *amici* has made a monetary contribution to the preparation and submission of this brief. The names of the firms are provided for identification purposes only.

interpreted in strict adherence to the Constitutional intent of bestowing patent protection only to inventions that are nonobvious as required by Title 35 U.S.C. §103 and this Court's standard for obviousness. Specifically, *amici* believe that a correct obviousness analysis turns on the level of skill of a person having ordinary skill in the art, and the relevant art. In contrast, the current Federal Circuit places incorrect emphasis for the determination of obviousness on the motivation to combine prior art references. Continued application of this erroneous obviousness standard with an undue emphasis on the motivation to combine as applied in this case stifles innovation by providing patent protection for obvious inventions.

This case provides the Court with the opportunity to affirm this Court's own precedent which established the obviousness standard, and affirm Federal Circuit decisions consistent with this Court's precedent. The Court's intervention will prevent the current Federal Circuit's from interpreting the nonobviousness requirement contrary to long established standards.

ARGUMENT

I. The Federal Circuit Erred in Deviating From the Statutory Standard of 35 U.S.C. §103 and From This Court's Controlling Precedent, *Graham v. John Deere*, in Solely Applying the Teaching, Suggestion, or Motivation Test to the Question of Obviousness

The statutory basis of patent and copyright protection is Article I, §8, clause 8 of the Constitution that provides in pertinent part:

> Congress shall have power... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and inventors the exclusive Right to their respective Writings and Discoveries.

In 1790 Congress implemented the Constitutional mandate by passing legislation, 1 Stat.110, that permitted the granting of a patent for a period not to exceed 14 years for an invention that was useful and new. The new and useful statutory requirements for patentability remained virtually unchanged for some one hundred and fifty years.

However, while Congress was always concerned with rewarding an inventor for a new and useful invention, in fact it was equally concerned with the persisting fear of granting patents on inventions which were in the public domain and thus in effect to prevent citizens from freely using information and inventions to which they had a right. Indeed the patent system was to be used to "Promote the Progress of Science and the useful Arts," not to impede.

Thus while it was statutorily required that a patent be "new and useful," in fact at least since *Hotchkiss v. Greenwood*, 52 U.S. 248, 265 (1850), this Court's precedent has required for patentability that an invention manifest more ingenuity and skill than that possessed by a skilled mechanic.

With the passage of Title 35 U.S.C. §103 (1952) of the Patent Act of 1952, Congress expressly added the requirement that a patentable invention be "non-obvious" in addition to the previous requirements of utility as required by 35 U.S.C. §101 and novelty as required by 35 U.S.C. §102. The Supreme Court officially interpreted Section 103 for the first time in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). That this Court fully recognized the impact of Section 103 is shown from the following:

> It is undisputed that this section uses, for the first time, a statutory expression of an additional

> requirement for patentability [non-obviousness], originally expressed in *Hotchkiss*.

Id. at 15.

The *Hotchkiss* case involved a patent that provided for the substitution of porcelain or potters clay for the metal portion of a doorknob. On appeal to this Court was a jury instruction which provided that the patent in suit was void if no other ingenuity or skill was necessary to construct the doorknob in a conventional manner with a different and cheaper material than that of an ordinary mechanic acquainted with the business. *Id.* This Court affirmed the jury instruction and held that if "no more ingenuity and skill [were] required ...than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity to make the invention patentable. *Id.* In other words, the improvement was the work of a skillful mechanic, not that of an inventor. In *Graham*, this Court also found that 35 U.S.C. 103 "was not intended by Congress to change the general level of patentable invention." *Graham*, 383 U.S. at 17. In specific the Court found that 35 U.S.C. 103 was "intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition, with Congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability." *Id.*

We next turn to the obviousness analysis conducted by the Court in *Graham*. Briefly, the patent in suit, No. 2,627,798, ("the '798 patent") relates to a chisel plow that utilizes a spring clamp to enable the upward movement of the plow shank when an obstruction is encountered in the plowing process. The use of a spring clamping arrangement enabled the plow to withstand the collision without breakage. In addition to the '798 patent in suit, *Graham* obtained U.S. Pat.

No. 2,493,811 ("the '811 patent"); both *Graham* patents enabled the chisel plow to avoid severe damage to its shank as a result of encountering rocks etc. in the plowing process. *Id.* at 19-21.

During trial defendant relied on four of the five patents cited during prosecution of the '798 application which matured into the '798 patent, as well as ten other U.S. patents and two prior use spring-clamp arrangements which had not been cited. The District Court and the Court of Appeals found that taken as a whole the prior art contained "all of the mechanical elements of the '798 patent." Moreover, the Glencoe prior use clamp was found to have "all of the elements of the '798 patent." *Id.* at 22.

Following a review of the prosecution history the application which matured into the '798 patent, this Court found that Graham emphasized to the USPTO that his invention was able to reduce wear between various parts which made up the chisel plow. In addition, Graham emphasized, in the litigation and before the courts, the greater flexing qualities of the '798 patent arrangement. This Court noted the absence of such argument to the USPTO. After careful consideration of the arguments on the basis of the '811 patent and the Glencoe prior art, the Court found that the '798 patent was obvious. In specific this Court stated:

> We cannot agree with the petitioners. We assume that the prior art does not disclose such an arrangement as petitioners claim in patent '798. Still we do not believe that the argument on which petitioners' contention is bottomed supports the validity of the patent....Certainly a person having ordinary skill in the prior art, given the fact that the flex in the shank could be utilized more effectively if allowed to run the entire length of the shank, would immediately see that

> the thing to do was what Graham did, i.e., invert the shank and the hinge plate. . .We find no nonobvious facets in the '798 arrangement. The wear and repair claims were sufficient to overcome the patent examiner's original conclusions as to the validity of the patent. However, some of the prior art, notably Glencoe, was not before him....in other words, the stirrup in Glencoe serves exactly the same function as the heel of the hinge plate in '798. The mere shifting of the wear point to the heel of the '798 hinge plate from the stirrup of Glencoe – itself a part of the hinge plate – presents no operative mechanical distinctions, much less nonobvious differences.

Id. at 38-41.

Calmer v. Cook Chemical Co., involved a plastic finger sprayer with a "hold down" lid that was used as a built-in dispenser for containers or bottles of liquid insecticide products. *Id.* at 42. As the Court explained, manufacturers of insecticides had faced serious problems in developing sprayers that could be integrated with the containers or bottles in which the insecticides were marketed for many years. *Id.* at 44.

The prior art consisted of the five prior art patents cited by the Patent Office examiner during prosecution of the application that matured into Pat. No. 2,627,798, the patent in suit. *Id.* at 49. Of these, the Court looked only to two of these patents, i.e. U.S. Patent No. 2,119,884 ("the '884 patent") and U.S. Patent No. 2,586,687 ("the '687 patent"). In addition *Calmer* cited a number of prior art references, that were not before the USPTO, but this Court only looked to U.S. Patent No. 2,715,480 ("the '480 patent").

In tracing through the prosecution history of the patent in suit, this Court noted the acceptance by the patentee to the

limitations to the claims that were imposed by the Examiner. *Id.* at 51-52. As a result of prosecution history estoppel, this Court concluded that *Cook Chemical* was "not now free to assert a broader view of [the invention covered by the patent in suit]. The subject matter as a whole reduces, then, to the distinguishing features clearly incorporated into the claims." *Id.* at 54.

In concluding that the patent in suit was obvious within the meaning of 35 U.S.C. §103, the Court stated:

> Cook Chemical [plaintiff] insists, however, that the development of a workable shipper-sprayer eluded Calmer, who had long and unsuccessfully sought to solve the problem. And, further, that the long-felt need in the industry for a device such as Scoggin's together with its wide commercial success supports its patentability. These legal inferences or subtests *do focus attention on economic and motivational rather than technical issues* and are, therefore, more susceptible of judicial treatment than are the highly technical facts often present in patent litigation. . .However, these factors do not, in the circumstances of this case, tip the scales of patentability. The Scoggin invention, as limited by the Patent Office and accepted by Scoggin, rests upon exceedingly small and quite non-technical mechanical differences in a device which was old in the art. At the latest, those differences were rendered apparent in 1953 by the appearance of the Livingstone patent [the '480 patent], and unsuccessful attempts to reach a solution to the problems confronting Scoggin made before that time became wholly irrelevant. It is also irrelevant that no one apparently chose to avail himself of knowledge stored in the Patent Office and readily available by the simple expedient of conducting a

> patent search – a prudent and nowadays common preliminary to well organized research. *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U.S. 485 (1900). To us, the limited claims of the Scoggin patent are clearly evidence from the prior art as it stood at the time of the invention.
>
> We conclude that the claims in issue in the Scoggin patent must fall as not meeting the test of §103, since the differences between them and the pertinent prior art would have been obvious to a person reasonably skilled in that art.

Id. at 57-59 (emphasis added).

Thus, this Court was able to resolve the obviousness issue in *Graham* and *Cook Chemical* by viewing the prior art through the eyes of a person skilled in that art in possession of the knowledge and understanding that it teaches, without resorting to the necessity to show suggestion or motivation to combine the prior art.

II. The Federal Circuit Erred in Deviating From Its Own Earlier Line of Precedent Beginning With *Kimberly-Clark Corp. v. Johnson and Johnson Co.* and *EWP v. Reliance* in Solely Applying the Teaching, Suggestion, or Motivation Test to the Questions of Obviousness

The current Federal Circuit is conducting a teaching, suggestion, or motivation test for combining prior art references to determine obviousness with ever increasing rigidity. As a result, it is failing to carry out the essence of what it is seeking to accomplish, namely, satisfying the statutory mandate of §103 by determining the obviousness of the differences between the subject matter sought to be patented and the prior art to which the subject matter pertains. To the contrary, the teaching, suggestion, or motivation test of the Federal Circuit may be bestowing patentability upon

that which should be found obvious, and as a result the Federal Circuit is permitting "the issuance of patents whose effects are to remove extant knowledge from the public domain". *Id.* at 9. The Federal Circuit has now assumed a position in conflict with Supreme Court precedent, its own logically-reasoned earlier precedent and the intent of Congress in enacting §103.

The nub of the conflict is the way the Federal Circuit is defining the involved art, i.e. the prior art to which the claimed invention relates and from which the patent claims differ. More specifically, the differences are those which exist from a comparison of the patent claims with the prior art relied on by the USPTO in granting the patent. The key to defining the involved art correctly is found by viewing the field of the claimed subject matter narrowly. Thereafter, it is necessary to focus on the differences between the claimed invention and the involved art, taken in its entirety and including the knowledge and understanding of a person skilled in the art. *Hotchkiss v. Greenwood,* 52 U.S. 248 (1850); *Graham v. John Deere,* 383 U.S. 1 (1966); *Kimberly-Clark Corp. v. Johnson and Johnson Co.,* 745 F.2d 1437 (Fed. Cir. 1984); *EWP v. Reliance,* 755 F.2d 898 (Fed. Cir. 1985). How to define the involved art correctly was illustrated by Supreme Court precedent in *Hotchkiss, John Deere* and *Cook Chemical* in part 1 of this brief. The following line of early Federal Circuit cases are analyzed to illustrate the Federal Circuit's faithful following of the mandate of this Court.

A. Kimberly-Clark

In Kimberly-Clark the District Court failed to apply the proper art because it did not take into consideration the significance of the claimed invention, i.e. an adhesive serving a dual function. As Judge Giles S. Rich stated: "The court must consider, on the obviousness issue, only what was

granted." *Kimberly-Clark,* 745 F.2d at 1449. More specifically, in defining the involved art, a court should look to see what differentiated the claimed subject matter from the prior art and caused the USPTO to grant the patent. The meaning of prior art in legal theory is, "knowledge that is available, including what would be obvious from it, at a given time to a person of ordinary skill in the art." *Id.* at 1453. In defining a person of ordinary skill in the art Judge Rich observed:

> It should be clear that that hypothetical person is not the inventor, but an imaginary being possessing "ordinary skill in the art" created by Congress to provide *a standard of patentability*, a descendant of the "ordinary mechanic acquainted with the business" of *Hotchkiss v. Greenwood*.

Id. at 1454.

As a result, the Federal Circuit reversed *Kimberly-Clark* because it found that the District Court's reasoning was fatally flawed. The Federal Circuit stated as the reason for its reversal that:

> After some general discussion, the court came to the conclusion that 'The inquiry...is whether two lines of adhesive, both of which penetrate the napkin and seal the cover as opposed to only one penetrating and sealing the cover, is a non-obvious invention'. At the outset, that is a misstatement of the issue, which is whether the *subject matter claimed would have been obvious*, at the time of Roeder's invention, to one of ordinary skill in the art...it is clear from the patent in suit, as at other times the trial court seems to have appreciated, that *adhesive had to serve the dual function* of (1) wrapper penetration and sealing and (2) garment attachment, a concept totally lacking in

> Champaigne, or in any other prior art reference, which is why the PTO allowed Roeder's claims. This essential of the claim invention seems to have been lost sight of by the trial court in its discussion of obviousness.

Id. at 1448.

B. EWP v. Reliance Universal

Similarly, in *EWP v. Reliance*, 755 F.2d 898 (Fed. Cir. 1985), the Federal Circuit again concluded that the involved art was not properly defined at the trial level. Judge Rich explained that the level of ordinary skill in the art is to be decided by the court *separate* from the determination of the art to which the claimed subject matter pertains, i.e. the involved art. The disclosure of the patent in question was directed to a method for producing wire mesh reinforced concrete pipes having a socket and ball and the claim itself referred to reinforced concrete. However, following the rationale of *Kimberly-Clark*, the Federal Circuit found that the pertinent prior art was determined to be wire-reinforcement of tubular form, the end portion of which can be enlarged by stretching, thus narrowing the field of inquiry to the invention actually claimed. *Id.* at 906.

Once having correctly defined the involved art, the analysis proceeded as follows:

> We cannot escape the conclusion that Francois did no more than apply *the presumed knowledge of the art* to provide an obvious solution to a simple problem: use crimped wire where there is a need in a subsequent forming step to expand or stretch it. *That presumed knowledge was, of course, available to all.* It is irrelevant whether or not Francois was aware of it. Patentability under the statute §103, is a decision made on the basis of a hypothesis: Would the

> invention have been obvious "to a person having ordinary skill in the art to which the subject matter pertains" in the light of all knowledge conveyed by 'prior art' as defined by statute and case law. It is a decision which must be made by courts because the law assigns that task to them. The function of witnesses, expert and otherwise, is to assist the court in determining and comprehending facts.
>
> The trial court properly undertook to decide upon the level of ordinary skill in the art, a point upon which neither party introduced evidence. In doing so, it clearly erred *in assuming that the involved art is making reinforced concrete products*. Considering the invention here claimed, we see it as a narrower field: the making of reinforcing wire cages and the like. We mention it only because *the view that concrete technology is involved* seems to have been the basis for finding several references not pertinent because they *did not relate to concrete pipe* or, even more specifically, bell and spigot pipe. This was a ground for effectively ignoring the relevant teaching of the German patent because the *concrete body* was different, made by a different process, and "there is no disclosure of a socket of increased diameter at one end". *That is of no moment*. Its significance is in its teaching that when a wire reinforcing cages is to be expanded, the wires undergoing stretching should be crimped or, in the words of the claim in suit, provided with "successive deformed non-rectilinear portions," which means the same thing.

Id. at 907 (emphasis added).

The correct finding that the claimed subject matter was unpatentable was reached because Judge Rich avoided the trap

of considering only the field of concrete products, more specifically to concrete pipe or even more specifically ball and spigot pipe, but instead properly looked to the involved art. Specifically, he looked to the relevant prior art as a whole and found that the use of crimped wire where there is a need in a subsequent forming step to expand and stretch is *knowledge available to all*.

Without doubt, clearly focusing on what the inventor finally succeeded in patenting leads to a correct determination of the scope and content of the involved prior art. *Kimberly*, 745 F.2d 1437. As emphasized in *EWP*, and later cited in a 1993 unpublished Federal Circuit decision, "a [prior art] reference must be considered for everything it *teaches* by way of technology and is not limited to the particular *invention* it is describing and attempting to protect." *EWP*, 755 F.2d at 907.

From the above-analysis it is clear that the involved relevant references count collectively toward the teachings of the prior art as a whole. *Lamb-Weston v. McCain Foods*, 73 F. 3d 546 (Fed Cir. 1996) (following *EWP* in determining the scope of the prior art).

When viewed collectively, any suggestion or motivation must ultimately be derived from the involved prior art; it can be derived solely from prior art teachings by combining such teaching with the presumed knowledge of one skilled in the art and using such teaching to solve the same or similar problem. *In re Hans Oetiker*, 977 F.2d 1443 (Fed.Cir. 1992) (Nies, J. concurring) (following EWP in recognizing the contribution of knowledge of one skilled in the art beyond a literal reading of the expressed teachings of a reference).

Thus, following this line of precedent, the Federal Circuit was able to resolve the obviousness issue by viewing the prior art through the eyes of a person skilled in that art in

possession of the knowledge and understanding that it teaches, without resorting to the necessity to show suggestion or motivation to combine the prior art.

III. The Supreme Court Should Review *KSR* and Direct the Federal Circuit to Return to the Obviousness Standard of *Graham v. John Deere* and the Federal Circuit's Earlier Line of Precedent

In deciding *Teleflex, Inc. v. KSR*, the Federal Circuit made a serious error in finding the *ultimate issue to be that of a motivation* to combine prior art, and more specifically, whether one of ordinary skill in the art would have been motivated to attach a known electronic control on the support bracket of a known adjustable pedal ssembly disclosed in the prior art. *Teleflex, Inc. v. KSR*, 119 Fed. Appx. 282 (Fed. Cir. 2005) (unpublished). This finding is wrong. The ultimate issue is obviousness under §103 irrespective of the methodology used to determine it.

Under the statute as interpreted by this Court and early Federal Circuit precedent, obviousness is grounded on a determination of whether a person skilled in the art would understand from his own technical and industrial knowledge that the teachings of the references or other statutory prior art are logically combinable and would (or would not), when combined, render the claimed subject matter obvious. This statutory role of the person skilled in the art must not be excluded from the analysis by seeking *motivation* only from printed references to determine whether or not prior art is combinable to establish obviousness.

The requirements in the Federal Circuit's summation in *KSR* show that its *teaching, suggestion, or motivation* test has become formulistic and does not serve its intended purpose of being an available, but not a mandatory, requirement which may be useful in helping to determine obviousness. The *KSR*

court requires that a district court make *specific findings* of a teaching, suggestion, or motivation to combine prior art teachings in the *particular manner claimed*. *Id.* at 290. Such a requirement would improperly restrict an analysis of obviousness because it limits the inquiry to only a narrow segment of the prior art, thus deviating from this Court's precedent. The requirement for *specific findings* of *teaching, suggestion, or motivation* to combine prior art references in the particular manner claimed is tantamount to requiring a finding of lack of novelty, even though the references are non-anticipatory by law because the prior art is applied in combination. An even more significant loss by the strictness of the test is that it fails to consider, and indeed excludes, the wide general knowledge of a skilled engineer which, if included, would extend the literal word-for-word reading of the references to include the prior art as a whole as required by §103.

In *KSR*, the Federal Circuit found it unobvious to position a known electronic throttle control on the support bracket for a known adjustable pedal assembly rather than on the assembly itself. The advantage said to be obtained by this configuration is that it is less expensive, less complex and more compact. The Federal Circuit found that there was no *specific motivation* taught in the prior art to construct the adjustable pedal-bracket combination *in the particular manner claimed*. *Id.* at 290. However, the court failed to take in to consideration that a skilled automotive engineer would know of the trend in the industry to make automotive assemblies more compact. With this knowledge in mind, he would think of repositioning of the component parts, including the electronic sensor in a way which would offer a reasonable expectation of success in achieving his objective. According to the Federal Circuit, a reference disclosing attaching an electronic control to pedal assembly housing rather than to its

support bracket lacks a suggestion as motivation to combine it with a prior art reference directed to an adjustable pedal assembly not disclosing the electronic control. This thinking would even deny the reasoning of *Hotchkiss v. Greenwood* because, in that case, there was no specific reference showing that potter's clay or porcelain could be substituted for metal in the construction of a known doorknob in a known manner. *Hotchkiss v. Greenwood,* 52 U.S. 248. Of course, in *Hotchkiss* the choice of potter's clay or porcelain was held to be the work of the skilled mechanic, because he, using his own knowledge, would understand how to make that choice from the then available materials for decorative or economic reasons.

A concept that the current Federal Circuit failed to apply in the *KSR* case is the knowledge and ability of the skilled engineer or chemist, a person who in the course of his or her daily work finds out, devises, or makes discoveries, a concept which has to be factored in to all obviousness considerations. Such knowledge and ability may or may not result in patentable inventions, and indeed such a person will not be the inventor of the particular invention being challenged. However, such a person will often be a peer or colleague in the 21st century world of team research. Nonetheless, the Federal Circuit persists in limiting the knowledge of the *hypothetical person* to whether a particular reference would be of *special interest or important in the field*. Whether the reference is of special interest or importance is irrelevant. Putting it in the words of Judge Oscar Hirsh Davis:

> The simple fact probably is that those teachings of the German and French patents were actually not well-known even in the pertinent art, but under the settled rule of §103 that fact is irrelevant – they were still part-and-parcel of the prior art even if they were not in fact well-known in the United States; they are an

> integral part of the "*presumed*" knowledge [of a person skilled in the art].

EWP, 755 F.2d at 908 (Davis, O.H., concurring).

While the Federal Circuit may give lip service to the existence of the hypothetical person because these words appear in §103, in point of fact, the contribution of such person's knowledge and understanding as a skilled engineer or chemist is often omitted in the Federal Circuit's analysis or instructions to a district court upon remand.

One of the difficulties in defining the role of the person skilled in the art occurs because of the Federal Circuit's failure to recognize the real problems faced by the inventor, expressed or implied in the patent specification. In *KSR*, the problem was said to be to design a smaller, less complex and less expensive pedal assembly. *KSR*, 119 Fed. Appx. at 284. So far, so good. At this point, instead of evaluating what the teachings of the prior art as a whole meant to a skilled engineer, the Federal Circuit looked to evaluate obviousness on the basis only to the *specific manner claimed*, not to the differences between what was specifically claimed and the prior art as a whole, as required by *Graham v. John Deere* and, consequently, erred in its conclusion.

As discussed above, *Hotchkiss, Graham, Kimberly-Clark,* and *EWP* make no mention of teaching, suggestion, or motivation in an obviousness determination. *Hotchkiss*, 52 U.S. 248; *Graham*, 383 U.S. 1; *Kimberly-Clark*, 745 F.2d 1437; *EWP*, 755 F.2d 898. Certainly, an explicit motivation to combine references is not the ultimate question; it is one small part of making the references count collectively; *i.e.* applying the prior art as a whole. An important part of the prior art as a whole is the extent of the knowledge attributable to the hypothetical person skilled in the art. When this knowledge is properly considered the teaching, suggestion, or

motivation required by the Federal Circuit to combine multiple prior art references naturally occurs. That knowledge, properly recognized and combined with the prior art teachings, may by itself provide the suggestion, or motivation leading to a conclusion of obviousness. *In re Oetiker*, 977 F.2d 1443.

Determining the actual meaning of the *teaching, suggestion, or motivation* test created by the Federal Circuit bears scrutiny, whether or not it is used to determine how to combine references. *Teaching*, in the broad sense, should be that of the prior art taken as a whole as required by §103. *Suggestion or motivation* may be synonymous or different, depending upon how the Federal Circuit applies its test on a case by case basis. *Motivation* should be considered simply the existence of a particular problem that one wishes to solve in particular art. In *Cook Chemical*, this Court recognized motivation from an economic basis, rather than technical. *Graham*, 383 U.S. at 57. *Suggestion* should mean at least the germ of an idea as to how to solve that problem and not the solution to the problem itself. If the solution to the problem *in the particular manner claimed* is taught by the prior art the claimed subject matter would lack novelty.

During the Federal Circuit's development of the *teaching, suggestion, or motivation* test, the expression "clearly suggests" or its equivalent often appeared. *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720 (1990). *Gillette* took the position that "the clear suggestion test is tantamount to requiring an exact statement of the claimed subject matter, which would rebut novelty altogether." *Id.* at 723. In response, the Federal Circuit pointed out that "we did not go that far in *Kimberly-Clark*, nor do we now." *Id.* The court further explained its view of clear suggestion to be:

> As to whether "clear suggestion" is a proper test of obviousness, we note initially that *Kimberly-Clark* is not the only instance in which we have made use of that phrase in a discussion of obviousness. Various other formulations of the requisite level of suggestion for combing prior art disclosures have been set forth in our precedent. For example, we have said that "obviousness does not require absolute predictability of success. . .For obviousness under §103, all that is required is a reasonable expectation of success."

Id. at 723-724 (emphasis added).

In the case now before this Court, the Federal Circuit has exceeded the teaching of *Kimberly-Clark* and *Gillette,* and has lowered the standard of patentability to reach the result feared by *Gillette* in settling a standard that would almost rebut novelty. *Id.* at 723. By doing this, the Federal Circuit is in conflict with their own precedent, as well as the precedent of this Court. In *Graham v. John Deere*, this Court determined that the enactment by Congress of §103 did not lower the standard of obviousness set by its precedents. *Graham,* 383 U.S. 1.

CONCLUSION

The economic impact of upholding patents which deprive the public of obvious knowledge which should be in the public domain has been discussed at length by the other *amici*. We believe that by continuing to adhere to this Court's precedential determination of obviousness and interpretation of §103 as explained in this brief, the level of patentability can be restored and the damaging effect of granting substandard patents can be curtailed. We urge this Court to grant KSR's Petition and, by its review, direct the Federal Circuit as to the correct methodology of an obviousness

determination with a recognition of the proper level of input by the hypothetical person skilled in the art.

Respectfully Submitted,

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